

REMARKS/ARGUMENTS

This Amendment and the following remarks are intended to fully respond to the Office Action dated October 20, 2005. In that Office Action claims 33-64 were examined, and all claims were rejected. More specifically, claims 33-62, and 64 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Beaton et al. (U.S.P.N. 6,037,937), and Eftekhari (U.S. Publ. No. 2002/0024505); and claim 63 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Beaton et al., Eftekhari, and Hoeksma (U.S.P.N. 6,271,835). Reconsideration of these rejections and/or withdrawal of the Final Office action is respectfully requested.

In this Response, no claims have been added, amended or canceled, and thus claims 33-64 remain pending in the application.

I. The Final Office Action Should be Withdrawn

In the prior response, Applicant utilized a Rule 131 declaration to swear behind the filing date of the published Eftekhari application. The Final Office action appears to have acknowledged the effectiveness of this declaration in overcoming the original filing date of the published application, but the Final action notes that the declaration was not effective to overcome the June 30, 2000 filing date of the abandoned parent application. Furthermore, the Examiner noted on page 8 of the Final action that the Applicant could request a copy of the abandoned parent application pursuant to 37 C.F.R. 1.14 (iv). However, this response fails to make a prima facie case of obviousness as required by the MPEP. For this reason alone, the Final Office action should be withdrawn. However, as explained in the following section, it is simply not possible for the Eftekhari application to be granted the priority date of the abandoned parent application for purposes of a 102(e)/103 rejection.

Reviewing the sole sentence within the Final Office action regarding the alleged ineffectiveness of the prior Rule 131 declaration, it appears that the Examiner is simply assuming that the cited portions of the Eftekhari CIP application can be found in the abandoned parent application. That is, there is no evidence in the record that the Examiner has reviewed the abandoned parent application to make an initial determination as to whether the later-filed CIP application would be accorded the filing date of the parent application for purposes of

35 U.S.C. § 120. Rather, it appears that the Examiner is suggesting that the Applicant perform this task in the first instance. However, the burden of establishing the § 102(e) date of a reference falls on the PTO, and a mere suggestion that the later-filed CIP application is entitled to the priority date of the earlier abandoned application fails to raise a prima facie case of obviousness. See MPEP § 706.02(f)(1) (containing guidelines that are to be followed when applying references under 35 U.S.C. 102(e) and instructing that the first step is to “determine the appropriate 35 U.S.C. 102(e) date for each potential reference by following the guidelines” set forth in the section).

In particular, MPEP § 706.02(f)(1) notes that the 102(e) date of a reference “is its earliest effective U.S. filing date, taking into consideration any proper benefit claims to prior U.S. applications under 35 U.S.C. 119(e) or 120 **if the prior application(s) properly supports the subject matter used to make the rejection in compliance with 35 U.S.C. 112, first paragraph.**” (Emphasis added.) Thus, consistent with the duty of the PTO to establish a prima facie case of obviousness, the MPEP requires that there be a finding of proper support in the CIP parent before the CIP itself can be applied (i.e., it is not the duty of the Applicant to show the absence of such support in the first instance, but rather the burden only shifts to the applicant once the Examiner has made a prima facie showing). See also, In re Wertheim, 646, F.2d 527, 537, 209 U.S.P.Q. 554, 564 (C.C.P.A. 1981), which instructs:

If, for example, the PTO wishes to utilize against an applicant a part of that patent disclosure found in an application filed earlier than the date of the application which became the patent, it must demonstrate that the earlier-filed application contains §§ 120/112 support for the invention claimed in the reference patent.

Thus, in light of the absence of a prima facie showing of obviousness in the Final Office action (i.e., no showing that the cited portions of the Eftekhari CIP application carried forward from the abandoned parent application), withdrawal of the Final Office action is respectfully requested. Furthermore, as explained in the following section, the fact that Eftekhari was cited as a **published application** rather than an issued patent under § 102(e) prevents that reference from being accorded the filing date of an **abandoned** parent application (regardless of the contents of that application).

II. The Eftekhari Publication Is Not Prior Art to the Pending Application

As noted above, all the pending claims stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Eftekhari (U.S. Publ. No. 2002/0024505) in combination with one or more additional references. Furthermore, the prior Response and Rule 131 declaration submitted by the applicant was apparently effective in overcoming the original filing date of the published Eftekhari application. However, because Eftekhari is a CIP of an **abandoned** application, Eftekhari could only be granted the effective priority date of the parent application if Eftekhari included **issued claims** that are fully supported by the disclosure of the abandoned parent application. See MPEP § 2136.03 (IV) (citing and interpreting In re Wertheim, 646, F.2d 527, 209 U.S.P.Q. 554 (C.C.P.A. 1981)).

The requirement that the **issued claims** of the Eftekhari CIP be supported by the disclosure of the abandoned parent application differs markedly from the above-described requirement that the abandoned parent application include the same subject matter cited against Applicant's pending claims. That is, while the PTO has the initial burden of determining the appropriate § 102(e) date for the reference as described in the above remarks (i.e., determining whether the cited portions of the published Eftekhari application were carried forward from the abandoned parent application), there is a further burden that must be met when attempting to carry back the critical 102(e) date of a **CIP** patent to the filing date of an **abandoned** parent application. As noted above, this additional requirement is best explained in the In re Wertheim case as follows:

We are asked by the PTO to apply the "carried over" principle set forth in Klesper to the present §§ 102(e)/103 rejection. Specifically, the solicitor argues that since this court said in Wertheim I that Pfluger II was "carried forward" into the Pfluger patent, and Pfluger I discloses essentially the same invention as Pfluger II, the Pfluger reference patent must be awarded the benefit of the Pfluger I filing date.

In responding to this argument, we first note that the Pfluger patent issued after a series of applications, the initial one (I), two continuation-in-part applications (II and III), and a continuation application (IV). Let us assume that Pfluger I disclosed subject matter A. Because two continuation-in-part applications followed, II may be said to contain subject matter AB, B representing new matter, and III may be said to contain ABC, C representing the additional

new matter in that application. Continuation application IV, of course, also contains subject matter ABC.

Instead of determining what filing date the Pfluger *patent* was entitled to as a § 102(e) reference for purposes of the §§ 102(e)/103 rejection, however, the board relied upon the language in Lund, that a disclosure which is “carried over” into the patent from previous applications may be used to defeat the patent rights of another inventor. In other words, rather than examining the Pfluger patent in the light of §§ 120 and 112, it reached back to Pfluger I and retrieved A, found it “carried over” into the patent and combined it with a secondary reference to find the Wertheim invention obvious.

Although this court apparently embraced this procedure in Wertheim I, such an approach in a situation where there are continuation-in-part applications ignores the rationale behind the Supreme Court decisions in Milburn and Hazeltine that “but for” the delays in the Patent Office, the patent would have earlier issued and would have been prior art known to the public. The patent disclosure in Milburn was treated as prior art as of its filing date because at the time the application was filed in the Patent Office the inventor was presumed to have disclosed an invention which, but for the delays inherent in prosecution, would have been disclosed to the public on the filing date. A continuation-in-part application, by definition, adds new matter to the parent application previously filed. Thus, the type of new matter added must be inquired into, for if it is critical to the patentability of the claimed invention, a patent could not have issued on the earlier filed application and the theory of Patent Office delay has no application.

Additionally, it is at this point in the analysis that § 120 enters the picture, for the phrase in § 102(e), “on an *application* for patent,” necessarily invokes § 120 rights of priority for prior co-pending applications. If, for example, the PTO wishes to utilize against an applicant a part of that patent disclosure found in an application filed earlier than the date of the application which became the patent, it must demonstrate that the earlier-filed application contains §§ 120/112 support for the invention claimed in the reference patent. For if a patent *could not* theoretically have issued the day the application was filed, it is not entitled to be used against another as “secret prior art,” the rationale of Milburn being inapplicable, as noted above. In other words, we will extend the “secret prior art” doctrine of Milburn and Hazeltine only as far as we are required to do so by the logic of those cases.

Initially then, the question becomes the familiar one of which filing date the Pfluger patent is entitled to for various purposes, including its effectiveness as a § 102(e) reference under § 103 evidencing “prior art.” *Lund, supra*. It is clear that it cannot be used as a reference under § 102(e) *alone* against the Wertheim invention as of the date of a Pfluger application which does not describe the Wertheim invention, as claimed.

Id. at 646 F.2d 536-37, 209 U.S.P.Q. 563-64 (internal citations and footnotes omitted).

Thus, Wertheim clarifies that, in the case of a continuation-in-part patent, a determination must be made as to whether the new matter added in the CIP was critical to the patentability of the invention claimed in the CIP patent. If so, a patent could not have issued on the abandoned parent application, and thus the Milburn doctrine cannot apply (i.e., the CIP patent cannot be given the date of the parent application for purposes of using the later CIP patent as 102(e) prior art). This requirement is further explained in MPEP § 2136.03 (IV) which is reproduced below in pertinent part:

IV. PARENT'S FILING DATE WHEN REFERENCE IS A CONTINUATION-IN-PART OF THE PARENT

Filing Date of U.S. Parent Application Can Only Be Used as the 35 U.S.C. 102(e) Date If It Supports the Claims of the Issued Child

In order to carry back the 35 U.S.C. 102(e) critical date of the U.S. patent reference to the filing date of a parent application, the parent application must (A) have a right of priority to the earlier date under 35 U.S.C. 120 and (B) support the invention claimed as required by 35 U.S.C. 112, first paragraph. "For if a patent could not theoretically have issued the day the application was filed, it is not entitled to be used against another as 'secret prior art' " under 35 U.S.C. 102(e). *In re Wertheim*, 646 F.2d 527, 537, 209 USPQ 554, 564 (CCPA 1981) (The examiner made a 35 U.S.C. 103 rejection over a U.S. patent to Pfluger. The Pfluger patent (Pfluger IV) was the child of a string of abandoned parent applications (Pfluger I, the first application, Pfluger II and III, both CIPs). Pfluger IV was a continuation of Pfluger III. The court characterized the contents of the applications as follows: Pfluger I--subject matter A, II-AB, III-ABC, IV-ABC. ABC anticipated the claims of the examined application, but the filing date of III was later than the application filing date. So the examiner reached back to "A" in Pfluger I and combined this disclosure with another reference to establish obviousness. The court held that the examiner impermissibly carried over "A" and should have instead determined which of the parent applications contained the subject matter which made Pfluger patentable. Only if B and C were not claimed, or at least not critical to the patentability of Pfluger IV, could the filing date of Pfluger I be used. The court reversed the rejection based on a determination that Pfluger IV was only entitled to the Pfluger III filing date. The added new matter (C) was critical to the claims of the issued patent.). Note that *In re Wertheim* modified the holding of *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967) as to "carrying back" the subject matter to the parent applications.

As is apparent from the above discussion, including the title of the above-quoted MPEP section, the parent filing date of a CIP can only be used if that parent application supports the

issued claims of the CIP (it is not enough to simply show that the subject matter cited in the CIP was carried forward from the parent - a showing that has not yet been made in this case as addressed in Section I. above). In the present case, the cited Eftekhari reference is not an issued patent but rather is only a published application. Therefore, it is not possible to determine whether any claims will eventually issue from this application, much less determine whether such claims find support in the abandoned parent application. Thus, not only does the burden fall upon the Examiner in the first instance to make the showing required by In re Wertheim and MPEP § 2136.03 (IV) (as described in the prior section of this Response), but in this case that burden cannot possibly be met given that the Eftekhari CIP application does not possess any issued claims (a recent check on PAIR shows the Eftekhari application to be under a final rejection).

Therefore, Eftekhari can only be cited as a § 102(e) reference as of its own filing date (January 19, 2001), and this date has already been overcome per the previously filed Rule 131 declaration. See the prior Amendment and Response explaining that the Rule 131 declaration overcomes the 12-day difference between the filing date of the present application (January 31, 2001) and that of Eftekhari.

In view of the prior Rule 131 declaration, as well as the inability of the PTO to demonstrate that the critical § 102(e) date for the published Eftekhari application can be carried back to the filing date of the abandoned parent application, it is evident that Eftekhari does not represent prior art to the present application. Therefore, because Eftekhari was cited in § 103(a) rejections of all the pending claims, reconsideration of the obviousness rejections is respectfully requested.

III. Conclusion

In light of the fact that the Eftekhari application does not constitute prior art to the present application, it is believed that the application is now in condition for allowance and such action is respectfully requested. Furthermore, if the pending claims 33-64 are not immediately allowed, withdrawal of the Final Office action is respectfully requested due to the failure of the Final Office action to present a prima facie case of obviousness.

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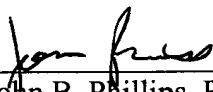
It is believed that no further fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

Respectfully submitted,

Date: December 15, 2005





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